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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/813,163

03/31/2004

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A8698

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23373 7590 03/31/2008  
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EXAMINER

SAYADIAN, HRAYR

ART UNIT

PAPER NUMBER

2815

MAIL DATE

DELIVERY MODE

03/31/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## **DETAILED ADVISORY OFFICE ACTION**

### **After Final Amendment Not Entered**

1. A proposed amendment submitted after a final rejection or other final action in an application, but before or on the same date of filing an appeal, may be admitted if: (1) the amendment cancels claims (without affecting scope of the disclosure or other pending claims) or complies with any requirement of form expressly set forth in a previous Office action; (2) the amendment presents the rejected claims in better form for consideration; or (3) the amendment touches the merits of the application but is accompanied with a showing of good and sufficient reason why the amendment is necessary and was not earlier presented. See, for example, 37 CFR § 1.116. A proposed amendment will not be entered absent persuasive reasons for why it should.

The after final response proposes at least amending independent claims 2 and 4 and adding new claims 37-40.

Clearly, the proposed claim amendments affect scope of the claims and therefore, possibly, the disclosure.

Clearly, the proposed amendments therefore raise new issues not considered before and require further consideration or search, or both. Resolving these new issues requires at least determining whether and how the proposed amendments introduce new matter.

Clearly, the proposed amendments therefore materially increase and complicate the issues for appeal, rather than reducing or simplifying the issues for appeal.

Clearly, the proposed amendments therefore place the application in worse form for appeal.

Additionally, there is no showing why the proposed amendments are necessary and were not earlier presented.

**Status of Pending Claims 1-36**

2. Claims 1-3, 5-14, 16-23, 25-34, and 36 remain withdrawn. And the objections and rejection in the previous Office Action, including rejecting pending claims 4, 15, 24, and 35 over the prior art, are maintained.

**Response to Applicant's Arguments**

3. The arguments in the 3/10/2008 "Reply" after the 10/10/ final action have been fully considered. These arguments however are not found persuasive.

The Reply contends that the restriction due to pending claim 2 reciting an isolator is not proper because FIG. 11 "shows the same FI/Attn as in FIG. 1." The Reply points to FIG. 5b and contends it shows the attenuator includes an isolator.

In response, Examiner respectfully notes that the facts on their face contradict this contention. The element distinguishing FIG. 1 from FIG. 11 is the "Isolator," not the "FI/Attn." Moreover, FIG. 11 shows an FI, not FI/Attn.

Respectfully, Examiner notes that the Reply reads more into FIG. 5b's disclosure than what FIG. 5b actually discloses. FIG. 5b shows (and is explicitly labeled by this application) "component illustration of filter, isolator and attenuator module." Clearly, on its face, the disclosure of FIG. 5b is of the attenuator being different from isolators 501 and 502, and not including them. Additionally, the optics art well recognizes that isolators are different from attenuators. Such a contention is simply unwarranted and therefore not convincing.

Examiner notes the After Final proposes deleting "an isolator module" from claim 2.

As to the prior art rejections, the Reply argues the characteristics directed to the detailed description rather than features recited in, and limiting the claims.

Although the detailed description may be used to understand recitations in a claim, only limitations in a claim limit scope of the claim and thus distinguish over the prior art. See, for example, *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993) (recognizing that the claims are interpreted in light of the specification, but noting that limitations from the

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specification are not read into the claims); see also M.P.E.P. § 2111.01II, and the precedents cited therein.

The Reply still appears to argue that the claims are directed to replaceable modules, which the Reply contends is not disclosed by the applied prior art. The Reply however fails to address the rebuttal in the Final Office Action of this contention. See the last paragraph in paragraph 11 on page 8 of the 10/10/2007 Office Action. Clearly, "carefully assembl[ing] and align[ing], as admitted by Applicants, reads on assembled and tested.

The Reply also argues recitations in proposed claims, including claim 4, which are not entered. Such arguments therefore are not ripe.

### CONCLUSION OF DETAILED ADVISORY OFFICE ACTION

4. The shortened statutory period for reply to this Office Action expires **FIVE MONTHS** from the mailing date of the 10/10/2007 Office Action. Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a). In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this Office Action.

Any inquiry concerning this communication or earlier communications from an Examiner should be directed to Examiner Hrayr A. Sayadian, at (571) 272-7779, on Monday through Friday, 7:30 am – 4:00 pm ET.

If attempts to reach Mr. Sayadian by telephone are unsuccessful, his supervisor, Supervisory Primary Examiner Kenneth Parker, can be reached at (571) 272-2298. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available only through Private PAIR. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. The Electronic Business Center (EBC) at 866-217-9197 (toll-free) may answer questions on how to access the Private PAIR system.

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<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<p><b>Application No.</b> 10/813,163</p>	<p><b>Applicant(s)</b> LIU ET AL.</p>	
	<p><b>Examiner</b> HRAYR A. SAYADIAN</p>	<p><b>Art Unit</b> 2815</p>	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 10 March 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See the attached explanation. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: none.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 4, 15, 24 and 35.
- Claim(s) withdrawn from consideration: 1-3, 5-14, 16-23, 25-34, and 36.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See the attached explanation.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

/BRADLEY W BAUMEISTER/  
Supervisory Patent Examiner, Art Unit 2891